

ORIGINAL

Express Mail Mailing Label No. E939731133US Date of Deposit: September 13, 2002. I hereby certify that this paper or fee is being deposited with the United States Postal Service Express Mail Post Office to Addressee service under 37 C.F.R. 1.10 on the date indicated above and is addressed to Box TTAB FEE, The Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

Vasuki Selvan
Vasuki Selvan

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Application)
for MISCELLANEOUS DESIGN)

TTAB FEE

U.S. Patent & TMO/TM Mail Rcpt. Dt. #57



09-13-2002

Applicant: Lerner New York, Inc.)

Serial No.: 76/273,023)

Filed: June 18, 2001)

International)

Class No: 25)

Published in the Official Gazette:)

June 25, 2002)

Page TM 641)

09/19/2002 JHARLEY 00000064 76273023

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NOTICE OF OPPOSITION

Levi Strauss & Co. (hereinafter "Opposer") believes it will be damaged by the registration of the Miscellaneous Design illustrated in and covered by Application Serial No. 76/273,023, filed on June 18, 2001, by Lerner New York, Inc. (hereinafter "Applicant"), and hereby opposes such registration.

Opposer is a Delaware corporation having its headquarters and its principal place of business at 1155 Battery Street, San Francisco, California 94111.

Applicant is, upon information and belief, a Delaware corporation with its place of business located at 460 West 33rd Street, New York, New York 10001.

Notice of Opposition

105085_1 Serial No. 76/273,023

This Notice of Opposition has been timely filed.

As grounds of opposition, Opposer alleges as follows:

1. As illustrated in the Official Gazette dated June 25, 2002, at Page TM 641, Applicant seeks to register the Miscellaneous Design illustrated in and covered by Application Serial No. 76/273,023 in International Class 25.

2. Opposer is the owner of the distinctive Arcuate Stitching Design Trademark (hereinafter the "Arcuate Trademark"), as reflected in the following representative Registrations issued on the Principal Register, both of which presently are in full force and effect, and both of which are incontestable under 15 U.S.C. § 1065, as shown by the records of the United States Patent and Trademark Office:

<u>Trademark</u>	<u>Registration No.</u>	<u>Registration Date</u>
Design Only	1,139,254	September 2, 1980
Design Only	404,248	November 16, 1943

True and correct copies of these Registrations are attached hereto as Exhibit A. Since at least as early as 1873, Opposer continuously has used its Arcuate Trademark on a variety of goods, including but not limited to jeans, pants, jackets, skirts, dresses and shorts.

3. No issue of priority exists with respect to Opposer's Arcuate Trademark as set out in Exhibit A and the Miscellaneous Design illustrated in and covered by Application Serial No. 76/273,023. Opposer's dates of adoption and first use of its trademark long precede the date of Applicant's intent to use application for this Miscellaneous Design.

4. Since adoption and first use of Opposer's Arcuate Trademark, Opposer continuously has marketed and presently is marketing its goods nationwide. Opposer's goods are

identified as originating from Opposer through the display of Opposer's Arcuate Trademark.

5. Since adoption and first use of Opposer's Arcuate Trademark, Opposer has expended and continues to expend substantial time, money, and effort in promoting its Arcuate Trademark to identify Opposer as the source of the goods displaying that trademark. As a result, Opposer believes and alleges that the public has come to recognize Opposer as the source of a variety of goods, including but not limited to jeans, pants, jackets, skirts, dresses and shorts, which display Opposer's Arcuate Trademark.

6. By virtue of its efforts and expenditure of considerable sums for promotional activities and by virtue of the excellence of its goods, Opposer has gained a valuable reputation for its Arcuate Trademark and has developed exceedingly valuable goodwill with respect to that trademark.

7. Registration of the Miscellaneous Design illustrated in and covered by Application Serial No. 76/273,023 will lead the public to conclude, incorrectly, that Applicant is or has been, and that Applicant's goods displaying said trademark are or have been, authorized, sponsored, or licensed by Opposer. Accordingly, issuance of any registration to Applicant for the Miscellaneous Design is contrary to the provisions of 15 U.S.C. § 1052(a) and will result in damage to Opposer and the public.

8. The Miscellaneous Design illustrated in and covered by Application Serial No. 76/273,023 is deceptively similar to Opposer's Arcuate Trademark so as to cause confusion, or to cause mistake or to deceive the public as to the origin of Applicant's goods bearing that trademark. Therefore, registration of said trademark is prohibited by 15 U.S.C. § 1052(d).

9. The Miscellaneous Design illustrated in and covered by Application Serial No.

76/273,023 creates the same, or essentially the same, commercial impression as Opposer's Arcuate Trademark. Accordingly, registration by Applicant of that trademark is likely to cause confusion, or to cause mistake or to deceive the public as to the source of Applicant's goods, all to the harm and damage of Opposer and the public. Therefore, registration of said trademark is prohibited by 15 U.S.C. § 1052(d).

10. Registration of the Miscellaneous Design illustrated in and covered by Application Serial No. 76/273,023 would constitute prima facie evidence of the validity of such Registration, of Applicant's ownership of that trademark, and of Applicant's exclusive right to use said trademark pursuant to the provisions of 15 U.S.C. § 1057(b). Such registration would be a source of damage and injury to Opposer and the public and would be contrary to the principles of registration set out in 15 U.S.C. §§ 1051 et seq.

11. Opposer's Arcuate Trademark is distinctive and famous within the meaning of 15 U.S.C. § 1125(c), the Federal Trademark Dilution Act of 1995. The Miscellaneous Design mark illustrated in and covered by Application Serial No. 76/273,023, when used, is likely to cause dilution of the distinctive quality of Opposer's Arcuate Trademark, in violation of the Federal Trademark Dilution Act of 1995, 15 U.S.C. § 1125(c), all to the harm and damage of Opposer and the public. Therefore, registration of said trademark should be refused under 15 U.S.C. §§ 1052 and 1063(a) (as amended by the Trademark Amendments Act of 1999.)

12. In summary, registration of the Miscellaneous Design illustrated in and covered by Application Serial No. 76/273,023 should be refused in view of the requirements of the Trademark Act of 1946, as amended, including specifically but not limited to the provisions of 15 U.S.C. §§ 1051, 1052, 1063, and 1127.

WHEREFORE, Opposer prays that this Opposition be sustained, and that registration to Applicant for the Miscellaneous Design illustrated in and covered by Application Serial No. 76/273,023 in International Class No. 25 be denied.

Opposer hereby files this Notice of Opposition in triplicate; the statutory filing fee of \$300.00 is submitted herewith.

Opposer hereby appoints the firm of Legal Strategies Group and Gail I. Nevius, a member of the Bar of the State of California, 5095 Christie Avenue, Emeryville, California 95608, telephone (510) 450-9600, its attorneys with full power of substitution and revocation, to prosecute this Opposition and to transact all business in the United States Patent and Trademark Office in connection therewith. All future communications in this Opposition should be directed to Opposer's attorney identified above.

DATED: September 13, 2002

Respectfully submitted,

LEGAL STRATEGIES GROUP

By: Gail I. Nevius
Gail I. Nevius
LEGAL STRATEGIES GROUP
5905 Christie Avenue
Emeryville, California 94608
Tel.: (510) 450-9600
Fax: (510) 450-9601

Attorneys for Opposer
LEVI STRAUSS & CO.

EXA



THE UNITED STATES OF AMERICA

TO ALL TO WHOM THESE PRESENTS SHALL COME:

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

December 04, 1998

THE ATTACHED U.S. TRADEMARK REGISTRATION 1,139,254 IS CERTIFIED TO BE A TRUE COPY WHICH IS IN FULL FORCE AND EFFECT WITH NOTATIONS OF ALL STATUTORY ACTIONS TAKEN THEREON AS DISCLOSED BY THE RECORDS OF THE UNITED STATES PATENT AND TRADEMARK OFFICE.

REGISTERED FOR A TERM OF 20 YEARS FROM *September 02, 1980*

SECTION 8 & 15

SAID RECORDS SHOW TITLE TO BE IN:

LEVI STRAUSS & CO.

A DELAWARE CORPORATION



By Authority of the
COMMISSIONER OF PATENTS AND TRADEMARKS

P. SWAIN

Certifying Officer

Int. Cl.: 25

Prior U.S. Cl.: 39

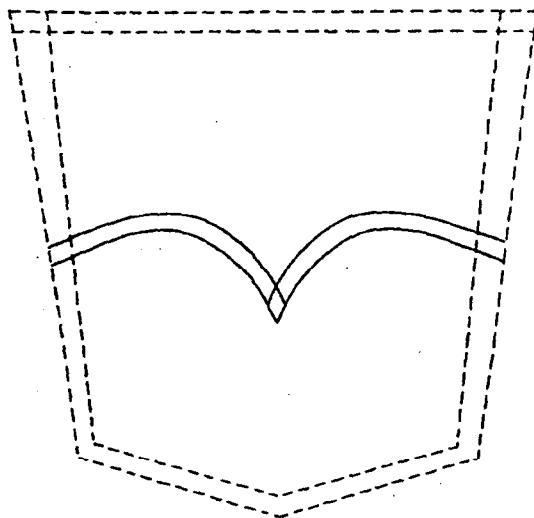
Reg. No. 1,139,254

Registered Sep. 2, 1980

United States Patent and Trademark Office

TRADEMARK

Principal Register



**Levi Strauss & Co. (Delaware corporation)
Two Embarcadero Ctr.
San Francisco, Calif. 94106**

**For: PANTS, JACKETS, SKIRTS, DRESSES AND
SHORTS, in CLASS 25 (U.S. CL. 39).
First use 1873; in commerce 1873.
Owner of U.S. Reg. No. 404,248.**

Ser. No. 169,399. Filed May 8, 1978.

M. J. LEAHY, Primary Examiner



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
OFFICE OF ASSISTANT COMMISSIONER FOR TRADEMARKS
2900 Crystal Drive
Arlington, Virginia 22202-3513

REGISTRATION NO: 1139254 SERIAL NO: 73169399 MAILING DATE: 08/06/2001
REGISTRATION DATE: 09/02/1980
MARK: MISCELLANEOUS DESIGN
REGISTRATION OWNER: LEVI STRAUSS & CO.
CORRESPONDENCE ADDRESS:

SARAH R. FULLER
LEGAL STRATEGIES GROUP
5905 CHRISTIE AVENUE
EMERYVILLE, CA 94608-1925

NOTICE OF ACCEPTANCE

15 U.S.C. Sec. 1058(a)(3)

THE COMBINED AFFIDAVIT AND RENEWAL APPLICATION FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 8 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1058.

ACCORDINGLY, THE SECTION 8 AFFIDAVIT IS ACCEPTED.

NOTICE OF RENEWAL

15 U.S.C. Sec. 1059(a)

THE COMBINED AFFIDAVIT AND RENEWAL APPLICATION FILED FOR THE ABOVE-IDENTIFIED REGISTRATION MEETS THE REQUIREMENTS OF SECTION 9 OF THE TRADEMARK ACT, 15 U.S.C. Sec. 1058.

ACCORDINGLY, THE REGISTRATION IS RENEWED.

THE REGISTRATION WILL REMAIN IN FORCE FOR CLASS(ES):
025.

HARPER, BARBARA A
PARALEGAL SPECIALIST
POST-REGISTRATION DIVISION
(703)308-9500

PLEASE SEE THE REVERSE SIDE OF THIS NOTICE FOR INFORMATION
CONCERNING REQUIREMENTS FOR MAINTAINING THIS REGISTRATION

NN 128497

THE UNITED STATES OF AMERICA

TO ALL TO WHOM THESE PRESENTS SHALL COME:

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

December 04, 1998

THE ATTACHED U.S. TRADEMARK REGISTRATION 404,248 IS CERTIFIED TO BE A TRUE COPY WHICH IS IN FULL FORCE AND EFFECT WITH NOTATIONS OF ALL STATUTORY ACTIONS TAKEN THEREON AS DISCLOSED BY THE RECORDS OF THE UNITED STATES PATENT AND TRADEMARK OFFICE.

REGISTERED FOR A TERM OF 20 YEARS FROM *November 16, 1943*
2ND RENEWAL FOR A TERM OF 20 YEARS FROM *November 16, 1983*
SECTION 8 & 15

REPUBLISHED SECTION 12C

SAID RECORDS SHOW TITLE TO BE IN:

LEVI STRAUSS & CO.

A DELAWARE CORPORATION



By Authority of the
COMMISSIONER OF PATENTS AND TRADEMARKS

P. SWAIN

Certifying Officer

Registered Nov. 16, 1943

Trade-Mark 404,248

Republished, under the Act of 1946, April 27, 1948, by
Levi Strauss & Company, San Francisco, Calif.

Affidavit under Section 8 accepted.

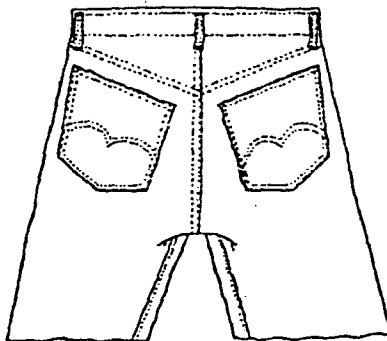
Affidavit under Section 15 received, Aug. 31, 1953.

UNITED STATES PATENT OFFICE

Levi Strauss & Company, San Francisco, Calif.

Act of February 20, 1905

Application September 25, 1942, Serial No. 453,769



STATEMENT

To the Commissioner of Patents:

Levi Strauss & Company, a corporation duly organized under the laws of the State of California and located at the city and county of San Francisco, State of California, and doing business at 98 Battery Street, San Francisco, California, has adopted and used the trade-mark shown in the accompanying drawing, for WAISTBAND TYPE OVERALLS, in Class 39, Clothing, and presents herewith five facsimiles showing the trade-mark as actually used by applicant upon the goods, and requests that the same be registered in the United States Patent Office in accordance with act of February 20, 1905. The trade-mark has been continuously used and applied to said goods in applicant's business since the year 1873. The trade-mark consists of double arcuate designs of orange color displayed on the hip pockets of the overalls as shown on the drawing. The mark is applied to the overalls

by stitching the double arcuate designs on the hip pockets with orange colored thread, or by painting the lines of said design on the hip pockets with orange colored paint.

No claim is made to the exclusive use of the representation of a pair of overalls.

The undersigned hereby appoints Castberg & Roemer, a firm composed of Thomas Castberg and Irving C. Roemer, whose address is 807 Crocker Building, San Francisco, California, and whose registration number is 15,030, as its attorneys, with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to receive the certificate of registration, and to transact all business in the Patent Office connected therewith.

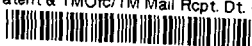
LEVI STRAUSS & COMPANY,
By DANIEL E. KOSHLAND,
Vice President.



LEGAL
STRATEGIES
GROUP

A LAW CORPORATION

U.S. Patent & TMOrc/TM Mail Rcpt. Dt. #57



09-13-2002

September 13, 2002

VIA EXPRESS MAIL

Box TTAB FEE
The Assistant Commissioner for Trademarks
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Re: Application Serial No. 76/273,023
Applicant: Lerner New York, Inc.
Mark: MISCELLANEOUS DESIGN
Opposer: Levi Strauss & Co.

Dear Sir or Madam:

Enclosed please find the original and two copies of the Notice of Opposition in the above-referenced matter, as well as a filing fee check in the amount of \$300.00, and a post card confirming receipt. Please date stamp and return the post card to our offices.

Thank you for your assistance in this matter. If you should have any questions, please do not hesitate to contact me.

Very truly yours,

Vasuki Selvan
Trademark Specialist
(510) 450-9608

Enclosures

02 SEP 20 AM 12:12
TRADEMARK TRIAL AND
APPEAL BOARD